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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,825	12/07/2001	Yasuo Shibusawa	TMI-109	7759

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EXAMINER

ROCHE, TRENTON J

ART UNIT PAPER NUMBER

2193

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,825	SHIBUSAWA ET AL.	
	Examiner	Art Unit	
	Trenton J. Roche	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to communications filed 6 April 2006.
2. Claims 1-16 are currently pending and have been examined.

Response to Arguments

3. Applicants' arguments, see pages 11-15 of the remarks, filed 6 April 2006, with respect to the rejection(s) of claim(s) 1-8, 11 and 16 under 35 U.S.C. §§ 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.
4. Applicants' arguments with respect to claims 9, 10 and 12-15 under 35 U.S.C. § 102(e) have been fully considered but they are not persuasive. The arguments presented in response to the 102 rejection (page 11 through the 1st paragraph of page 13) present arguments which, while applicable to some of the independent claims, are not commensurate in scope with independent claims 9, 12 and 15. Applicants present arguments concerning the necessity of having software for operation of the constituent element, and stress that Smith et al. do not concern themselves with downloading software "required for the operation of the constituent element..." Regardless of whether this is true or not, the Examiner notes that this claim language does not appear in any of claims 9, 10 and 12-15, consequently, nothing in the claim precludes the downloading and installation of "non-required" software. Accordingly, the rejection of claims 9, 10 and 12-15 under Smith et al. is considered proper and maintained.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 9, 10 and 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,067,582 to Smith et al. (hereinafter "Smith").**

Per claim 9:

Smith discloses:

- storing system configuration information of a user's computer system and identification information for identifying the user's computer system (Note col. 7 lines 2-15)
- accepting from the user's computer system the identification information of the user's computer system (Note col. 7 lines 2-15)
- sending, to the user's computer system, software corresponding to the system configuration information of the user's computer system that is determined from the stored system configuration information which corresponds to the accepted identification information (Note col. 7 lines 25-28)

substantially as claimed.

Per claim 10:

Art Unit: 2193

Smith discloses managing and collecting a fee from a user as claimed (Note col. 8 line 66 to col. 9 line 4, and further, note Figure 3)

Per claims 12 and 15:

Smith discloses:

- sending identification information of a first computer system to a second computer system (Note col. 7 lines 2-15)
- accepting software corresponding to system configuration information of the first computer system, which is indicated by system configuration information stored in the second computer that corresponds to the identification information sent from the first computer system (Note col. 7 lines 25-28)
- conducting setup processing in order to make the software accepted in the accepting step into an executable state in the first computer (Note col. 7 lines 28-35)

substantially as claimed.

Per claim 13:

Smith further discloses installation as claimed (“install the software...” in col. 7 line 39)

Per claim 14:

Smith further discloses storing software as claimed (“transfer of installation modules...” in col. 7 line 27. The modules are stored so as to be executed by the client.)

Art Unit: 2193

7. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,859,924 to Kroening.

Per claim 1:

Kroening discloses:

- storing information related to a constituent element of a user's computer system and software required for operation of the constituent element and also storing identification information for identifying a user's computer system that is supplied to the user's computers, and system configuration information indicating hardware of the user's computer system (Note col. 6 line 58 – col. 7 line 6)
- accepting from the user's computer system the identification information of the user's computer system (Note col. 6 line 58 – col. 7 line 6)
- sending, to the user's computer system, software required for the operation of the constituent element of the user's computer system that is determined from the stored system configuration information which corresponds to the accepted identification information (Note Figure 3 item 320 and the corresponding sections of the disclosure. Further, Kroening discloses in col. 6 lines 11-17 that the software may be malfunctioning or corrupted, consequently, the update would be required for correct operation.)

substantially as claimed.

Per claim 2:

Kroening further discloses managing and collecting a fee from a user as claimed (Note col. 6 line 7)

Art Unit: 2193

Per claim 3:

Kroening discloses:

- a first database for storing information related to a constituent element of a computer system and software required for operation of the constituent element (Note Figure 2, item 220 and the corresponding sections of the disclosure.)
- a second database for storing identification information for identifying a computer system supplied to a user, and system configuration information indicating hardware of the computer system (Note Figure 2, item 218 and the corresponding sections of the disclosure.)
- an accepting means for accepting from the user's computer system the identification information given to the user's computer system (Note col. 6 line 58 – col. 7 line 6)
- first determining means for determining system configuration information which corresponds to the accepted identification information, with reference to the second database (Note col. 9 lines 32-37)
- second determining means for determining software required for operation of the constituent element which is indicated in the system configuration information, with reference to the first database (Note col. 9 lines 32-37)
- sending means for sending the determined software to the user's computer system (Note col. 9 lines 48-52)

substantially as claimed.

Per claim 4:

Kroening discloses:

Art Unit: 2193

- sending identification information of a first computer system to a second computer system
(Note col. 6 line 58 – col. 7 line 6)
- accepting software corresponding to system configuration information of the first computer system, which is indicated by system configuration information stored in the second computer that corresponds to the identification information sent from the first computer system (Note col. 9 lines 48-52)
- conducting setup processing in order to make the software accepted in the accepting step into an executable state in the first computer (Note col. 9 lines 48-52)

substantially as claimed.

Per claims 5 and 6:

Kroening further discloses executing a specified installation software and storing software received from the second computer system as claimed (Note col. 9 lines 48-52)

Per claim 7:

Note the rejection regarding claim 4.

Per claim 8:

Note the rejection regarding claims 1 and 3.

Per claim 9:

Note the rejection regarding claim 1.

Art Unit: 2193

Per claim 10:

Note the rejection regarding claim 2.

Per claim 11:

Note the rejection regarding claim 3.

Per claim 12:

Note the rejection regarding claim 4.

Per claims 13 and 14:

Note the rejections regarding claims 5 and 6, respectively.

Per claim 15:

Note the rejection regarding claim 4.

Per claim 16:

Note the rejection regarding claim 8.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2193

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trenton J Roche
Examiner
Art Unit 2193

TJR

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